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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,679	04/11/2001	RACHEL BAR-SHAVIT	108366	3009

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Oliff & Berridge
PO Box 19928
Alexandria, VA 22320

EXAMINER

LACOURCIERE, KAREN A

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/744,679

Applicant(s)

BAR-SHAVIT, RACHEL

Examiner

Karen A. Lacourciere

Art Unit

1635

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☒ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1, 5, 6, 9-11, 14-26.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE: Applicant's amendments filed 06-17-2004 change the scope of claim 9 from a vector comprising an antisense to a vector encoding the antisense, which would require a new search and new considerations. Additionally, the amendments to claim 20 changes the scope to "comprising", which would require a new search and considerations..

Continuation of 3. Applicant's reply has overcome the following rejection(s): If entered, Applicant's amendments would overcome the rejection of record of claim 20 under 35 USC 112, second paragraph. The proposed amendments, if entered, would overcome the rejection of record of claim 9 under 35 USC 102.

Continuation of 5. does NOT place the application in condition for allowance because: Applicant argues that antisense molecules were enabled at the time of the invention and refers to the Declaration filed 06-17-2004 as providing evidence that the claimed antisense molecules can be used to treat cancer, including cancers other than breast cancer, specifically melanoma. This is not persuasive because the Declaration filed 06-17-2004 has not been considered because there is no reason why it was not earlier presented. Further, Applicant argues breast and melanoma cancers are enabled, however, the scope of the claims is not directed to breast and melanoma cancers. Applicant's arguments do not address the claimed scope, which specifically includes metastatic cancer of cytotrophoblast cells and conditions unrelated to cancer, the broad genus of disorders encompassed in disorders involved in the implantation of a placenta in a female subject. Applicant's arguments do not address the scope of the claimed methods and breast and melanoma cancers do not appear to correlate with these other types of diseases. Applicant argues that the amended claims are not anticipated by Coughlin et al. because the vector of Coughlin et al. does not encode SEQ ID NO:7 and does not comprise an antisense molecule. This is not persuasive because the proposed amendments have not been entered. The nucleic acid disclosed by Coughlin et al. comprises SEQ ID NO:7 and meet all of the limitations of the claims and, therefore, anticipate the claims .


KAREN A. LACOURCIERE, Ph.D
PRIMARY EXAMINER